



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Patent Application of

Philippe Brun et al.

Application No.: 09/601,222

Filed: September 14, 2000

For: SYSTEM AND METHOD FOR
MANAGING COMPUTER
APPLICATIONS SECURITY

) MAIL STOP AF
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) Group Art Unit: 2132
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) Examiner: ZAND,KAMBIZ
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) Confirmation No.: 8563
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejections in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Applicants respectfully submit that the current record does not provide a sufficient basis on which to proceed with the Appeal.

Rejection Under 35 U.S.C. §112

Claim 1 stands rejected under the second paragraph of 35 U.S.C. §112, on the grounds that the phrase "allocatable..." renders the claim indefinite. In relevant part, claim 1 recites "a number of security registers which are selectively allocatable to any one of a plurality of said directories..." The final Office Action states that this terminology is unclear "in that neither means/method steps nor interrelationship of means/method steps are set forth in these claims in order to achieve the desired results...." As an explanation, the Office Action states:

It is not clear "allocatable" is an affirmative statement with respect to claim 1 or not, that is the method steps are being executed (narrow claim language) or not (broader claim language).

As a suggestion for overcoming this rejection, the Office Action proposed the phrase "selectively allocating a number of security registers to any one of a plurality of said directories."

In the response filed August 15, 2005, Applicants addressed this rejection by pointing out that it appeared to be based upon a misunderstanding of the claim. The above-quoted language refers to "method steps" and actually proposes the insertion of a method step, i.e. "selectively allocating..." to overcome the rejection. However, claim 1 is a system claim, not a method claim. See the Amendment filed August 15, 2005, at page 7, last paragraph, and page 8, first paragraph.

In the Advisory Action dated August 30, 2005, the Examiner indicated that he considered claim 1 as a system claim and not a method claim, with reference to the word "means" in the phrase "means/method steps." However, the explanation of the rejection, quoted above, does not make any reference to "means", or structure. It is all phrased in terms of method steps. The explanation in the Advisory Action further emphasizes the Examiner's analysis of the claim from the perspective of a method, not structure. It states "examiner considers 'allocatable' phrase as a limitations not necessary performed [i.e., a verb], and for that reasons has given suggestion such as 'allocating' [an active verb]."

The statement of rejection does not set forth a clear issue for presentation to the Board of Appeals. The recitation of "a number of security registers which are selectively allocatable to any one of a plurality of said directories" positively sets forth an attribute of the security registers, not a method step. This recitation distinguishes the claimed subject matter from prior art registers that were dedicated to individual respective directories. When the claim is read as a whole, and in light of the specification, the meaning of this phrase can be readily understood. The final Office Action does not provide a clear statement of the reasons why this recitation is not considered to comply with the requirements of 35 U.S.C. §112. As such, the rejection should not be permitted to go up on Appeal.

Rejections Under 35 U.S.C. §103

One of the distinguishing features of the invention, noted above, is that the security registers are selectively allocatable among any one of a plurality of directories organized in a hierarchy. In their response filed August 15, 2005, Applicants pointed out that neither of the primary references disclosed such a feature. See, for example, the argument starting with the first full paragraph on page 9, through the third full paragraph on page 10.

The record is unclear as to the manner in which the Examiner is interpreting the references to suggest this subject matter. Referring to the final Office Action dated March 14, 2005, at the top of page 6 the Examiner appears to be taking the position that the Proust et al patent discloses a number of security registers which are selectively allocatable to any one of a plurality of directories. However, further down on the same page, at lines 16-17, the Office Action appears to be stating precisely the opposite, i.e. that Proust et al "do not disclose that security registers or particular location of the memory that corresponds to a security registers is allocated to and it is under a directory." (emphasis added) This latter statement is again repeated, in bold, in the rejection of claims 2 and 4. Note page 9, lines 6-8.

The Advisory Action states that the reference to column 14, lines 6-9 and 28-47 of the Proust et al patent addresses the selection or allocation of the security registers. First, this statement is not supported by the final Office Action itself. At about the middle of page 6, the final Office Action cites the noted portion of the Proust patent, stating that it discloses how the pointer points to the location of the storage. The Action goes on to explain "examiner considers location of the storage where the identifier points to as corresponding to the security register that holds the message that contains reference secret or rights." This explanation does not provide any indication of the manner in which the Examiner was treating the "selectively allocatable" language of the claims. Rather, it only explains how the

reference was being interpreted to disclose security registers, per se. In fact, the explanation is followed by the above-quoted statement that Proust et al "do not disclose" that a security register is allocated to and is under a directory.

Second, whether or not the Examiner intended this citation to the Proust patent to address the "selectively allocatable" recitation, Applicants' response pointed out that it does not disclose the claimed subject matter. As noted in the last full paragraph on page 9 of their response, even if one assumes that secret references are stored in registers pursuant to the teachings of the Proust patent, there is no disclosure *how* such registers are allocated among applications. Specifically, there is no disclosure that the registers can be selectively allocated among any one of a plurality of directories, rather than be dedicated to a particular application, or directory.

In view of the foregoing, it is unclear whether the Proust patent is being relied upon as teaching registers that are selectively allocatable among any one of a plurality of directories. Furthermore, if the Proust patent is being relied upon for such a teaching, the final Office Action does not explain how it is being interpreted to do so. The mere fact that a pointer is used to indicate a location in memory does not inherently mean that such a location is selectively allocated among any one of a plurality of directories.


In summary, the issues are not sufficiently well joined for presentation to the Board of Patent Appeals and Interferences. The analysis of claim 1 from a process, or method, perspective creates uncertainty as to the precise nature of the rejection under 35 U.S.C. §112. In addition, the rejections under 35 U.S.C. §103 do not explain how the references are being interpreted to disclose security registers that are selectively allocatable among any one of a plurality of directories.

If the rejections are not withdrawn, prosecution should be reopened so that the record can be clarified before it is presented to the Board of Appeals.

Respectfully submitted,

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